

**REMARKS**

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding office action is respectfully requested.

**1. Specification**

The Examiner has objected to the various informalities or typographical errors in the specification in page 20, lines 18 and 19, which have been corrected above as appropriate.

The first two paragraphs of the specification are amended to clarify the priority claims.

**2. Rejections under 35 U.S.C. § 102**

The Examiner has rejected claims 1-81 under 35 U.S.C. § 102(e) as being anticipated by EP 1 084 995.

The Examiner asserted that the applicable 35 U.S.C. § 102(e) shall be the one prior to the implementation of the American Inventors Protection Act of 1999 (AIPA), because (i) the instant application was not filed before November 29, 2000; and (ii) the instant application was not voluntarily published under 35 U.S.C. § 122(b).

Applicant respectfully traverses this rejection.

The Manual of Patent Examining Procedure provides:

**WHEN EXAMINING PRE PG-PUB APPLICATIONS, ONLY U.S. PATENTS AND SIRS ARE ELEGIBLE AS PRIOR ART UNDER 35 U.S.C. 102(e)**

The reference must be a U.S. patent or Statutory Invention Registration (SIR) to be eligible for use in a 35 U.S.C. 102(e) rejection. See, e.g., *ex parte smolka*, 207 USPQ 232 (Bd. App. 1980) (A foreign patent document with priority back to an abandoned U.S. application cannot be the basis for 35 U.S.C. 102(e) rejection. The foreign document cannot be prior art until it is patented or published.). U.S. patents and SIRs can be used in 35 U.S.C. 102(e) rejections as of their filing dates.

**WHEN EXAMINING PG-PUB APPLICATIONS, ONLY U.S. PATENTS, U.S. APPLICATION PUBLICATIONS, CERTAIN INTERNATIONAL APPLICATION PUBLICATIONS AND SIRS ARE ELIGIBLE AS PRIOR ART UNDER 35 U.S.C. 102(e)**

When examining PG-PUB applications, in addition to U.S. patents and SIRs, U.S. application publications and certain international application publications are also available as prior art under 35 U.S.C. 102(e) as of their filing dates.

The MPEP, Eighth Edition, 2136.01 (emphasis original).

The reference the Examiner relied upon in formulating the rejection, EP 1 084 995, is a foreign patent document. It is neither a US patent nor a SIR. Therefore, it cannot serve as a basis for rejection under 35 U.S.C. § 102(e), if the pre PG-PUB version of 35 U.S.C. §102(e) is applied.

In addition, contrary to the Examiner's assertion, the present application was filed on June 6, 2001, which was after November 29, 2000. As a result, it was subjected to publication under 35 U.S.C. § 122(b). Indeed, the present application was published as US2001/0027025 A1 on October 4, 2001. Therefore, the applicable law should be the current version of 35 U.S.C. §102(e).

Even if the current version of 35 U.S.C. §102(e) is applied to the present application, EP 1 084 995 is not a proper reference under 35 U.S.C. §102(e). This is because it is not a U.S. patent, not a U.S. patent application publication, nor is it an international application publication. It is a foreign patent application publication.

### **3. Conclusion**

Based upon the above amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1-81 and a prompt Notice of Allowance thereon.

The Office action was mailed on February 4, 2003. Thus the 3-month shortened statutory period for replying thereto expired on May 4, 2003. Therefore, Applicant is requesting a one-month time extension under 37 C.F.R. § 1.136(a) to make this Response timely. Should additional time extension be required, Applicant respectfully requests that the Office grant such additional time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

The undersigned attorney is granted limited recognition by the Office of Enrollment and Discipline of the USPTO to prosecute certain patent applications in capacity of an employee of Corning Incorporated. A copy of the document granting such limited recognition is submitted herewith. It is also respectfully requested this copy be entered into the file of the present application.

Please direct any questions or comments to the undersigned at (607) 248-1253.

Respectfully submitted,

CORNING INCORPORATED



Siwen Chen

Limited Recognition: See Document

Corning Incorporated

Patent Department

Mail Stop SP-TI-03-1

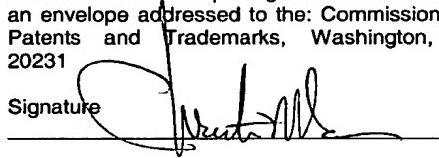
Corning, NY 14831

Date: May 30, 2003

Date of Deposit: May 30, 2003

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Date: <u>May 30, 2003</u>
Date of Deposit: <u>May 30, 2003</u>
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